

October 14, 2003
Case No.: AUS920010763US1 (9000/74)
Serial No.: 10/007,215
Filed: November 5, 2001
Page 3

-- REMARKS --

The present amendment replies to a final Office Action dated October 3, 2003. Claims 1-20 are currently pending in the present application.

Applicants wish to thank the Examiner for the interview with their counsel Paul M. Hlerko on October 8, 2003. During that interview, counsel was informed that the Examiner has withdrawn the Section 112 rejections previously levied against claim 19. Applicants regret that their counsel and the Examiner were unable to come to agreement with respect to the 103(a) rejections currently levied against claims 1-20.

A. Claims 1, 5-7, 8-10, 14-18 were rejected under 103(a) as unpatentable over Giboney in view of Jang.

The rejection of claims 1, 5-7, 8-10 and 14-18 under 35 U.S.C 103(a) is traversed. For this 103(a) rejection to stand, each and every element of the claimed invention must be taught or suggested by the references themselves, and there must be some motivation or suggestion to combine the references, in the references themselves, to arrive at the claimed invention.

Neither Giboney nor Jang provide any suggestion or motivation to combine the references. In order to prove a prima facie case of obviousness, the Examiner is required to provide affirmative evidence to support such a position. As the Examiner is well aware, the motivation to modify or combine must come from the references themselves. See MPEP 2143.01. A conclusory allegation that "[1]t would have been obvious to one of ordinary skill in the art" entirely fails to meet the Examiner's evidentiary burden to prove a prima facie case. The motivation to combine or modify cannot come from the Examiner, without the taking of official notice, or preparation of an Examiner's affidavit. Without some evidence of a motivation to combine, this rejection cannot stand.

October 14, 2003
Case No.: AUS920010763US1 (9000/74)
Serial No.: 10/007,215
Filed: November 5, 2001
Page 4

Furthermore, the mere fact that the references could be combined to arrive at the claimed invention (which Applicants do not concede) is insufficient to prove a prima facie case. See MPEP 2143.01, *In Re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and *In Re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While Applicants do not concede that the combination of the references would result in the claimed invention, nonetheless there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

Furthermore, it should be noted that the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See *Graham v. John Deere Co.*, 383 U.S. 1, (1965). In this case, the Examiner may have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness. In view of the fact that the Examiner was entirely unable to support the allegation of obviousness with a citation to either Giboney or Jang, the Examiner's use of impermissible hindsight is apparent.

Specifically, the references do not teach or suggest, alone or in combination, that the optical fiber module further comprises an upper connector and a lower portion, the upper connector comprising a pair of rearward mounting screw holes and the lower portion comprising a pair of forward mounting screw holes, as claimed in claims 1 and 10. Claims 5-9 and 14-18 depend from claims 1 and 10 respectively, and are allowable over Giboney in view of Jang for at least the same reasons.

The Examiner alleged in a phone message for Applicants' counsel that column 3, lines 11-13 of Jang provides the suggestion to combine. However, this citation to the references does not provide any teaching or suggestion to combine the references in such a way as to create an "optical fiber module further [comprising] an upper connector and a lower portion, the upper connector comprising a pair of rearward mounting screw holes and the lower portion comprising a pair of forward mounting screw holes," as claimed in

October 14, 2003
Case No.: AUS920010763US1 (9000/74)
Serial No.: 10/007,215
Filed: November 5, 2001
Page 5

claims 1 and 10. At most, the citation to Jang teaches that screws may be used to fasten a module to a circuit board – a teaching and suggestion that is a far cry from the invention claimed in Claims 1 and 10.

Withdrawal of the rejections to claims 1, 5-7, 8-10 and 14-18 is requested.

B. Claims 2-4, 11-13, and 19-20 were rejected under 35 U.S.C. 103(a) as unpatentable over Giboney and Jang in view of Carden.

The rejection of claims 2-4, 11-13 and 19-20 under 103(a) is traversed.

Claims 2-4 depend directly or indirectly from claim 1 and are therefore allowable over Giboney and Jang in view of Carden for at least the same reasons as claim 1 argued above. Furthermore, any claim depending from a non-obvious claim is also non-obvious. See MPEP 2143.03 and *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (where an independent claim is non-obvious, any claims depending therefrom are also non-obvious.).

Claims 11-13 depend directly or indirectly from claim 1 and are therefore allowable over Giboney and Jang in view of Carden for at least the same reasons as claim 1 argued above. Furthermore, any claim depending from a non-obvious claim is also non-obvious. See MPEP 2143.03 and *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (where an independent claim is non-obvious, any claims depending there from are also non-obvious).

Claim 19 is an independent claim including the same element of “optical fiber module further comprises an upper connector and a lower portion, the upper connector comprising a pair of rearward mounting screw holes and the lower portion comprising a pair of forward mounting screw holes” and is therefore allowable over Giboney and Jang in view of Carden for at least the same reasons as argued above. Claim 20 depends directly from claim 19 and is therefore allowable over Giboney and Jang in view of Carden for at least the same reasons as claim 19 argued above. Furthermore, any claim

October 14, 2003
Case No.: AUS920010763US1 (9000/74)
Serial No.: 10/007,215
Filed: November 5, 2001
Page 6

depending from a non-obvious claim is also non-obvious. See MPEP 2143.03 and *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (where an independent claim is non-obvious, any claims depending therefrom are also non-obvious).

Furthermore, to sustain this 103(a) rejection, each and every limitation of the instant invention must be taught or suggested by the prior art. Because Giboney and Jang in view of Carden does not teach or suggest each and every limitation, the prior art cannot render the instant application unpatentable.

Giboney and Jang in view of Carden does not teach or suggest "the upper fiber connector portion comprising a pair of rearward mounting screw holes and the lower fiber connector portion comprising a pair of forward mounting screw holes" as claimed in claims 1 and 10.

Giboney teaches a three-part connector connected by an aligning member that inserts into alignment holes. See Giboney, column 6 at lines 26-41. Further, Giboney does not teach or suggest, contrary to the Examiner's assertion, that the connector half is perpendicularly disposed to the die carrier, as is claimed in independent claims 1 and 10. As noted by the Examiner, Giboney does not teach or suggest that the connector is an "input/output connector," as is claimed in independent claims 1 and 10.

Additionally, it is not possible to arrive at the instant invention by modifying the prior art invention. As noted in the instant invention, on page 7, lines 1 - 9, the instant invention provides a structure capable of "top down" assembly. Such a method is impractical with Giboney's device, which uses the aligning members that are to be threaded through the alignment holes – see FIG. 1A of Giboney. As can be seen in FIG. 1A of Giboney, top down assembly of the Giboney packaging system is impractical, as the alignment members 62 and 63 would impact with the upper surface up the die carrier 22 and the upper surface of the fiber optic connector 64. The multiple pieces of the Giboney device further frustrate an attempt to assemble the device in a top down fashion – where the instant device comprises multiple parts assembled into a single unit, the Giboney device comprises multiple units. Thus, whereas the device mounting 22 and the

October 14, 2003
Case No.: AUS920010763US1 (9000/74)
Serial No.: 10/007,215
Filed: November 5, 2001
Page 7

cover assembly 52 of Giboney (see column 4-5) are multiple units, the instant invention comprises multiple pieces (i.e. the upper connector and the lower portion) into a single unit. The instant invention cannot be rendered unpatentable by Giboney and Jang in view of Carden.

Indeed, there is no evidence in the record, other than an unsupported and conclusory assertion of obviousness, to support a finding of obviousness in this case. The Examiner has not pointed to any suggestion or motivation in the art, has not provided an Examiner's affidavit, and has not taken official notice of any facts that would be known to those of ordinary skill in the art. Without any evidence to support a prima facie case of obviousness, this rejection cannot stand.

Withdrawal of the rejections to claims 2-4, 11-13 and 19-20 is requested.

October 14, 2003
Case No.: AUS920010763US1 (9000/74)
Serial No.: 10/007,215
Filed: November 5, 2001
Page 8

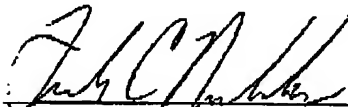
SUMMARY

Applicants submit that claims 1-20, as amended, fully satisfy the requirements of 35 U.S.C. §§ 101, 102, 103, and 112. In view of the foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,
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